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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,959	02/26/2002	Seah H. Lim	010.00131	5006

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EXAMINER	
UNGAR, SUSAN NMN	
ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/082,959	LIM ET AL.	
	Examiner	Art Unit	
	Susan Ungar	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *24 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) *1-16* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1-16 are pending in the application and are currently under prosecution.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group 1. Claim. 2 is drawn to a method for determining regression or progression of cancer comprising assaying a patient for level of nucleic acid molecule which encodes Sp17, classified in Class 435, subclass 6.

Group 2. Claims 2-4 drawn to a method of generating SP-17 specific immune effector cells ex vivo, Classified in Class 435, subclass 240.2

Group 3. Claim 5 is drawn to ex vivo antigen presenting cells, classified in Class 435, subclass 240.2.

Group 4. Claim 6 is drawn to isolated cytotoxic T cells, classified in Class 435, subclass 240.2.

Group 5. Claim 7 is drawn to a method of treating cancer comprising administering CTL, classified in Class 424, subclass 93.1.

Group 6. Claims 8-9 are drawn to a method of diagnosing cancer comprising assaying nucleic acid molecules encoding Sp17, classified in Class 435, subclass 6.

Group 7. Claims 10-12 are drawn to an immunoconjugate, classified in Class 424, subclass 178.1.

Group 8. Claims 13-14 are drawn to a method of treating cancer comprising administering an immunoconjugate, classified in Class 424, subclass 178.1.

Group 9. Claims 15-16 are drawn to a method of imaging cancer cells, classified in Class 424, subclass 178.1.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions 1, 3, 4, 7 as disclosed are biologically and chemically distinct, unrelated in structure and function, made by and used in different methods and are therefore distinct inventions.

Inventions 2, 5- 6, 8-9 are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success.

The inventions of Groups 3/4 and 2 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (i) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § **806.05(h)**]. In the instant case the APC product and the CTL product as claimed can be used in a materially different process such as production of antibodies against the APC and the CTL.

The inventions of Groups 4 and 5 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (i) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § **806.05(h)**]. In the instant case the CTL product as claimed can be used in a materially different process such as production of antibodies against the CTL.

The inventions of Groups 7 and 8-9 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following

can be shown: (i) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § **806.05(h)**]. In the instant case the immunoconjugate product as claimed can be used in a materially different process such as production of anti-idiotypic antibodies.

The inventions of Groups 1, 6 are unrelated to any of the product inventions claimed since those products are not used in any of the methods of inventions 1 and 6.

The inventions of Groups 2 and 7 are not at all related because the invention of group 7 is not used in any of the methods of Group 2.

The inventions of Groups 5 and 3/7 are not at all related because the invention of Groups 3/7 are not used in any of the methods of Group 5.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Group 7 is further subject to election of a single disclosed species.

Claims 10-11 are generic to a plurality of disclosed patentably distinct species comprising antibodies conjugated to therapeutic agents wherein said agents are (a) anti-tumor agent, (b) cytotoxin, (c) radioactive agent, (d) antibody, (e) enzyme, all of claim 12.

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (571) 272-0837. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787. The fax phone number for this Art Unit is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application

in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.

Susan Ungar, PhD
Primary Patent Examiner
August 13, 2004